II. General Remarks Concerning This Response

Claims 1-23 are currently pending. In this response, independent claims 1, 11, 17, and 22 are amended; no claims are added; and claims 8 and 23 are canceled.

The pending Office action contains an objection to the drawings; a set of formal drawings are being mailed separately from this response, which is being faxed.

Prior art references from other co-pending patent applications that are related to the present patent application are being submitted in an IDS that is being mailed separately from this response.

The Office action contains a request to submit a substitute specification because the original specification contains numerous typographical errors; a substitute specification is being mailed separately from this response.

The Office action objected to the specification for containing a copyright notice that does not conform with the requirements of the MPEP; a new copyright notice will be submitted in the substitute specification.

The pending Office action for the present patent application contains an objection to the specification in accordance with MPEP § 608.01 because the specification contains embedded "browser-executable code", such as HyperText Markup Language (HTML) or eXtensible Markup Language (XML) tags. Applicant has not modified the specification to remove these HTML tags because the present invention is directed to a process or a system for manipulating such markup language tags. As stated in MPEP § 608.01(a), if the forms of browser-executable code are part of an applicant's invention

and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. § 112, ¶ 1, examiners should not object to such tags.

The pending Office action for the present patent application contains a rejection under 35 U.S.C. § 112, ¶ 2, against claim 8. Claim 8 has been amended to correct the insufficient antecedent basis for "the flat file".

III. Rejections under Provisional Double Patenting

Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of co-pending patent application serial numbers 09/409,600, 09/409,372, and 09/409,376 that are commonly assigned with the present patent application. This rejection is respectfully traversed.

As a preliminary issue, it is difficult for Applicant to argue against the rejection because the rejection lacks a comparison of the specific elements of the claims in the various applications. On pages 11 and 12 of the Office action, the rejection states the following in its entirety:

> The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending applications and the instant application are claiming common subject, as follows:
>
> parsing a document object model and inserting code into it based on identification of a tag, and then generating and executing the code.
>
> Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

There is no reasoning nor argument comparing/contrasting the pending claims as is required in a proper obviousness-type double patenting rejection. Applicant notes that MPEP 804 states the following:

> Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:
>
> (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
>
> (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
>
> (C) Determine the level of ordinary skill in the pertinent art; and
>
> (D) Evaluate any objective indicia of nonobviousness.
>
> The conclusion of obvious-type double patenting is made in light of these factual determinations.
>
> Any obvious-type double patenting rejection should make clear:
>
> (A) The differences between the inventions defined by the conflicting claims--a claim in the patent compared to a claim in the application; and
>
> (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in a patent.
>
> When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art.

The pending obvious-type double patenting rejection clearly fails to meet the requirements specified by the MPEP.

It appears that the rejection was formed on the observation that the patent applications merely have some common subject matter, which is not a proper basis for rejection. The rejection merely asserts that most of the claims of the present application are not patentably distinct from all of the claims in the copending patent applications without providing any indication of differences between the claims in the patent and the present application nor any argument as to why any differences would have been obvious to one of ordinary skill in the art.

Applicant argues that the pending claims in the copending patent applications and the pending claims in the present application are clearly different and non-obvious with respect to the other claims. For example, one of the pending independent claims of the present application, as amended, reads as follows:

1. A method for serving a web page, comprising the steps of:

registering a set of custom tags in a tag library, wherein the tag library contains one or more elements defining custom tags, wherein an element defining a custom tag contains an attribute for a tag handler that processes an instance of the custom tag;

processing a given file into XML compliant code;

translating the XML compliant code into an object model representation having at least one custom tag;

processing the object model representation to generate executable code; and

invoking the executable code to generate the web page.

For purposes of comparison, the following recitations contain one independent claim from each of the other cited copending applications; each claim is either an original claim or an amended claim as will be amended in a separate response for an Office action in the respective patent application.

Patent Application Serial Number 09/409,600:

1. A method for processing an object model representation having a set of one or more custom tags, comprising the steps of:

(a) for each custom tag in the object model representation:

retrieving a given node in the representation; and

invoking a handler for the given node to replace the custom tag with a given object; and

(b) after all custom tags in the object model representation have been processed in step (a), collapsing the object model representation into a minimum number of method blocks.

Patent Application Serial Number 09/409,372:

11. A method for compiling a web page into an XML Document Object Model (DOM), the web page having at least first and second code blocks having script code written in different scripting languages, comprising the steps of:

examining the DOM to identify any nodes that identify a given code block;

for each node identifying a given code block:

creating a new node representing a Java method definition as a child node of a root element;

replacing the node that identifies the given code block with a node representing a Java method call to the Java method definition; and

moving the given code block's child nodes under the new node representing the Java method definition.

Patent Application Serial Number 09/409,376.

21. A process for serving a web page, the process comprising the steps of:

prior to receiving a request for the web page, generating a Java object that implements an interface that defines a method for performing a function against an element in a Document Object Model (DOM) tree representing the web page;

in response to receiving an initial request for the web page:

generating a DOM tree representing the web page;

replacing a custom tag in the DOM tree with a script; and

processing the DOM tree to generate a servlet having a method call that is generated as a result of processing the script, wherein execution of the method call invokes the method in the Java object; and

in response to receiving the initial request and a subsequent request for the web page, executing the servlet, thereby invoking the method in the Java object.

Clearly, the pending independent claims of the present patent application are directed to the processing of an input file to create an output document by generating and invoking executable code. In contrast, the pending claims in the copending patent applications are directed substantially to various processes for modifying a DOM representation of a document. While the subject matter is related, the claims contain very different processes.

With these significant differences, Applicant maintains that one of ordinary skill in the art would not have been motivated by teachings in the prior art to modify any of the claimed subject matter in the copending patent applications in such a way as to reach the pending claims of the present application without the use of hindsight facilitated by the teachings of the present application. Applicant notes that an assumption has been made that impermissible hindsight has been used in this instance because there is no additional substantive argument in the rejection.

For this and other reasons, Applicant believes that the provisional obviousness-type double patenting rejection should be withdrawn.

IV. Rejections under 35 U.S.C. § 103(a)—Obviousness

The Office action has rejected claims 1-3, 6-8, 10, and 23 under 35 U.S.C. § 103(a) as being unpatentable over

Gonsalves, "Lutris Server Divides Duties", published 07/11/99, in view of Peligri-Lopart et al., *JavaServer Pages™ Specification*, Version 1.1--Public Release, 08/18/99. The Office action has also rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Gonsalves and Peligri-Lopart et al. and further in view of *Extensible Stylesheet Language (XSL) Specification*, W3C Working Draft 04/21/99. Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gonsalves and Peligri-Lopart et al. and further in view of Wood et al., *XMLC Tutorial*, Version 1.02, 07/01/99. Claims 11-14, 16-19, 21, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. in view of Gonsalves and Peligri-Lopart et al.. Claims 15 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. and Peligri-Lopart et al. and further in view of *Extensible Stylesheet Language (XSL) Specification*. These rejections are traversed.

Each of the independent claims, as amended, contains a new element that reads substantially: "wherein a tag library contains one or more elements defining custom tags, wherein an element defining a custom tag contains an attribute for a tag handler that processes an instance of the custom tag". In the present invention, a custom tag defines a semantic of given content on a page, which may be uniquely specified by a web page author. Web page authors can use this mechanism to add custom tags to the page markup; custom tags serve as markers that initiate the invocation of tag handlers that, in turn, perform reorganization or manipulation of the document. A set of related custom tags can be collected and packaged into a

custom tag library. Each custom tag has an identifier and a set of one or more attributes, including a tag handler attribute. The tag handler attribute specifies a tag handler that can be either a class, e.g., a Java class, or a stylesheet. The tag handler is the entity that performs the manipulation of the document in which an instance of the custom tag appears as document markup.

The amended feature is not disclosed by the applied prior art nor the prior art of record. The specification explicitly discusses the fact that the JSP 1.0 specification teaches custom tags and a tag extension mechanism, i.e., a tag library mechanism. However, the JSP 1.0 specification does not teach the amended feature of the pending claims of the present application. The specification of the present application clearly distinguishes the present invention from the JSP 1.0 specification. The specification of the present application states on page 19, last paragraph:

> [T]he JSP 1.0 specification included a tag library mechanism that defines how to plug in a tag. The specification, however, left the details of the taglib mechanism completely open, with the exception that a URL must be used to specify the location of the taglib.

This statement is supported in the final draft of the JSP 1.0 specification, which has been cited by Applicant in the IDS that is being mailed as part of Applicant's current response to the pending Office action. The final draft of the JSP 1.0 specification states in Chapter 1, p. 17, last paragraph:

> The JSP 1.0 specification has mandatory and optional features. JSP 1.0 enables a tag extension mechanism for the creation of custom tags but such a mechanism will not appear until a later version of the specification.

The subsequent section of the specification of the present application then describes a specific mechanism for implementing a custom tag library, and the amended feature of the claims is directed to this specific mechanism. Hence, Applicant reiterates that the JSP 1.0 specification does not teach the features of the pending claims of the present application. Although the JSP 1.1 specification describes a specific mechanism for implementing a custom tag library, it should be noted that each of the pending independent claims states that the tag handler is specified as an attribute in a definition of a custom tag, which is not shown in the JSP 1.1 specification nor other prior art references.

Applicant asserts that the above-noted deficiencies in the rejections are sufficient to require the withdrawal of the rejections based on the applied prior art. The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the

Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

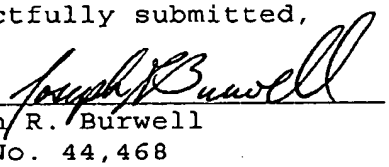
With respect to the pending claims, the rejections argue that a combination of the applied prior art references discloses the claimed features, but Applicant has shown above that the applied prior art references fail to disclose the features of the claims as amended. Hence, the rejections do not establish a *prima facie* case of obviousness with respect to the claims. Therefore, the rejections of all pending claims under 35 U.S.C. § 103(a) in view of the applied prior art have been shown to be improper, and the claims are patentable over the applied references. Applicant requests the withdrawal of the rejections.

V. Conclusion

For any outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

DATE: June 10, 2003

Respectfully submitted,



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